



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
PSTM0024/MRK

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on March 16, 2006

Signature

Typed or printed

name Marilyn R. KhorsandiApplication Number
09/684,861Filed
10/6/2000First Named Inventor
Bilibin, PaulArt Unit
3623Examiner
Van Doren, Beth

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 45744☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

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March 16, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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forms are submitted.

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Marilyn R. Khorsandi
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Bilibin, Paul et al.
Application No. : 09/684,861
Filed : October 6, 2000
Title : Apparatus, Systems and Methods for Determining Delivery
Time Schedules for Each of Multiple Carriers
Grp./Div. : 3623
Examiner : Van Doren, Beth
Docket No. : PSTM0024/MRK

PRE-APPEAL BRIEF REQUEST FOR REVIEW REASONS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
Pasadena, CA 91101-4710
March 16, 2006

Commissioner:

In the Office Action dated December 20, 2005, a final rejection, Claims 1-13, 15-17 and 19-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Thiel (U.S. Patent No. 5,699,258; "Thiel") in view of FedEx (www.fedex.com; "FedEx"). The Office Action did not list Claims 22 and 23 in the rejection in Topic 3 but rejected Claims 22 and 23 in the text of Topic Number 18 of the Office Action, citing Thiel and FedEx.

After carefully considering the rejections, a pre-appeal brief panel review of the rejection of the Claims is respectfully requested on the grounds described in more detail below with reference to the Claims as amended in the Amendment and Response filed in response to the Office Action dated July 6, 2005. This Request is filed pursuant to the guidelines for requesting a pre-appeal brief conference as presented in the Official Gazette (the "OG"), dated July 12, 2005. This Request is timely filed within the three-month period set by the Examiner because it is filed before the expiration of March 20, 2006. Reconsideration and allowance of the application in view of this Request is respectfully requested.

A. NO SHOWING UNDER MPEP §2143 FOR EACH LIMITATION OF EACH CLAIM

It is respectfully asserted that the Office Action did not, as is required under MPEP §2143, indicate how the cited references disclose, anticipate, teach or suggest each of the limitations of the rejected Claims.

For example, the Office Action did not, as is required under MPEP §2143, indicate how the cited references disclose, anticipate, teach or suggest each of the limitations of, e.g., Claim 1. Claim 1 is directed to a shipping management computer system that is programmed, among other things, to: "... determine a respective potential cross-comparison delivery schedule ... [that] comprises a respective delivery date and a respective delivery time for each respective particular delivery service of the plurality of delivery services offered by each respective particular carrier of the plurality of carriers ...". It is respectfully asserted that neither the Thiel nor the FedEx references disclose, anticipate, teach or suggest the above-cited limitation of Claim 1.

In rejecting the Claims of the present application, the Examiner cited, among other things, a table in the Thiel reference (located in Thiel at Col. 11, lines 1-13), and concluded that Thiel discloses determining a potential cross-comparison delivery schedule comprising a plurality of respective service-specific carrier-specific delivery schedules to ship the particular respective parcel.

As compared to the above-recited limitations of amended independent Claim 1, it is respectfully submitted that nothing in Thiel, including the cited Thiel table, discloses a system programmed to *determine* a schedule comprising delivery dates and times as claimed by amended independent Claim 1 (and as similarly claimed in independent Claims 4 and 7). Rather, as compared to disclosing a *determination* of a schedule by the Thiel system as claimed by independent Claim 1, Thiel describes the cited Thiel table as a *stored* table of services and fees of various carriers. Thiel, col. 10, lines 65-67. That is, the Thiel table is a pre-existing stored table, as compared to a schedule *determined* by the system of Thiel.

Further, it is respectfully submitted that Thiel does not disclose determination of a schedule comprising *delivery dates and times*. Rather, the cited stored Thiel table lists, for five (5) different carriers, such shipping features as Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt] Charge, Discount for greater than 100 items, Discount for greater than 1000 items, and Discount for greater than 10000 items. Thiel, col. 11, lines 1-13. No delivery dates or times are listed.

Further, it is respectfully submitted that the cited stored table depicted in Thiel, listing Express Delivery as a setting for each of five carriers, does not constitute a determination of a cross-comparison delivery schedule. That is because, depending on each carrier's rules, the mere listing of an offering of a delivery service, such as an Express Delivery service, does not necessarily demonstrate any particular date for delivery. For example, if a shipment is initiated on a Friday, a weekend, or a day preceding a holiday, depending on a given carrier's rules regarding Saturday, Sunday, or holiday delivery, the shipment may not be delivered by an Express Service on the day following the date on which the shipment was initiated.

Yet further, it is respectfully submitted that Thiel, including the cited stored Thiel table, does not disclose determination by the Thiel system of a cross-comparison delivery schedule comprising "... a respective delivery date and a respective delivery time for *each respective particular delivery service* of the plurality of delivery services *offered by each respective particular carrier* of the plurality of carriers that would deliver the particular respective parcel ..." as recited by amended independent Claim 1 (and as similarly claimed in amended independent Claims 4 and 7).

Rather, Thiel explains that the stored table is used to perform a mask search *after* the user has already "defined the required services":

The user of the franking machine first defines the required services. This is done by entering the date with regard to the ship-to zone (the destination zone) and the desired additional services such as express delivery (E), return receipt (R), etc. ... In a first selection process, a mask (a first step selection) searches the carriers which offer the desired services.

Thiel, col. 11, lines 15-23.

As compared to determining a cross-comparison schedule comprising a delivery date and time for each respective delivery service of a plurality of a plurality of delivery services offered by each carrier of a plurality of carriers that would deliver a parcel, it is respectfully submitted that Thiel uses the settings in the cited stored table to perform a "fee optimization" to determine the best price. Thiel, col. 11, lines 27-30.

Further, it is respectfully asserted that combining Thiel with FedEx does not disclose, anticipate, teach or suggest each of the limitations of, e.g., Claim 1. As compared to the above-cited limitations recited by Claim 1, FedEx discloses, for

example, a service type, such as "FedEx Standard Overnight", and describes delivery as "Next-business-day delivery by 3 pm". As compared to the above-cited limitations recited by Claim 1, it is respectfully asserted that the description of "Next-business-day delivery" is not disclosure of a "delivery date". Rather, as compared to the above-cited limitations recited by Claim 1, it is respectfully asserted that, in order for a delivery date to be determined, a user of FedEx would need to consult a calendar (mentally or visually), and depending on the circumstances, would need to consult a clock, to determine the day and time of shipping and the corresponding "next business day." For example, if the user was shipping a package on, e.g., a Friday, the user would need to identify the date of the following Monday, or if the following Monday were a holiday, the following Tuesday. Further, if the user was shipping the package after a particular cut-off time, the package may not be delivered the following day -- that is, the package may be delivered two days after the shipment date.

It is respectfully asserted that the above-described steps that a FedEx user would have to take to determine the delivery date of the "next business day" are evidence that FedEx does not disclose the above-cited limitations of Claim 1. Similarly, it is further respectfully asserted that the mere description of "Next-business-day delivery" is not a *determination* of "... a respective potential cross-comparison delivery schedule ... [that] comprises a respective delivery date and a respective delivery time ... " as recited by, e.g., Claim 1 and as evidenced by the steps described above that a FedEx user would need to take to determine the date of the next business day.

For reasons similar to those described above regarding Claim 1, it is respectfully asserted that neither Thiel nor FedEx, even when combined, discloses, anticipates, teaches or suggests all of the limitations of independent Claim 4 (which recites "... determin[ing] ... a ... cross-comparison delivery schedule ... [that] comprises a respective delivery date and a respective delivery time ...") or independent Claim 7 (which recites "... determining ... a ... cross-comparison delivery schedule ... [that] comprises a respective delivery date and a respective delivery time ...").

For reasons similar to those described above regarding Claims 1, 4, and 7, it is respectfully asserted that neither Thiel nor FedEx, whether considered alone or in combination with any other references of record, discloses, anticipates, teaches or

suggests all of the limitations of independent Claim 10. Claim 10 recites "... determining a first set of delivery schedules ... [for a] first carrier ... each one of said first set of delivery schedules ... comprising a delivery date and a delivery time ... determining a second set of delivery schedules ... [for a] second carrier ... each one of said second set of delivery schedules ... comprising a delivery date and a delivery time ... displaying to the user said first set of delivery schedules ... and ... simultaneously displaying to the user said second set of delivery schedules...". For the reasons given above with respect to Claims 1, 4 and 7, it is respectfully asserted that neither Thiel nor FedEx disclose determining schedules comprising delivery dates and times.

Because, for the foregoing reasons, it is respectfully asserted that Thiel, whether considered alone or in combination with any other reference of record, does not anticipate, disclose, teach or suggest all of the limitations of amended independent Claims 1, 4, 7, and 10 of the present application, it is further respectfully asserted, therefore, that Thiel, whether considered alone or in combination with any other reference of record, does not anticipate, disclose, teach or suggest all of the limitations of dependent Claims 2-3, 5-6, 8-9, 11-13, 15-17, and 19-23.

B. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,

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